

REMARKS

Amendments

Claim 5 is amended to eliminate references to cyclodextrin. No new matter has been added.

Claim 9 has been amended to add the limitation found on page 13 of the specification.
No new matter has been added.

Withdrawn claims 43 to 63 are canceled without prejudice.

Claim 64 is added. Claim 64 is similar to claim 5 but is defined to state that at least one sugar molecule is ^{13}C labeled but the modifying group is not specifically labeled. This is supported on page 5, item (4) in the middle of the page and by Example 3 on pages 24 to 26. No new matter has been added.

Claim 65 is added. Claim 65 is similar to claim 5 but has a reference to ^{13}C -labeled galactosyl modifying group deleted and a feature --wherein said sugar molecule is ^{13}C -labeled and said modifying group is a galactosyl group -- is added. The feature is supported by Example 3 on pages 24 to 26. No new matter has been added.

Claim Rejections – 35 USC §102

Claims 5 and 8 have been rejected under 35 USC 102(b) as being anticipated by Nunez et al. Applicants respectfully disagree at least for the following reason.

Nunez et al. discloses β -D-[1- ^{13}C] galactopyranosyl residues of disaccharides. In column 2, page 490, first complete paragraph from the bottom, Nunez et al. discloses the following ^{13}C -labeled compounds: [1- ^{13}C]Gal β -(1 \rightarrow 4)GlcNAc (N-acetylglucosamine); [1- ^{13}C]Gal β -(1 \rightarrow 4)GlcNAc- β -hexanolamine; and [1- ^{13}C]Gal β -(1 \rightarrow 4)Glc (lactose). That is, in Nunez et al. it is

In other words, the claimed ^{13}C -labeled compound has at least two sugar residues (oligosaccharide) **plus** the claimed modifying group(s), whereas Nunez et al.'s ^{13}C -labeled compound is a disaccharide with only two sugar residues, of which the galactopyranosyl group is ^{13}C -labeled.

Thus, it is clear that claimed compound of amended claim 5 is not disclosed, taught or suggested by Nunez et al. at least for the above reason. Applicants submit that amended claim 5 is not anticipated by Nunez et al.

Claim 8 depends from claim 5 and therefore, at least for the same reason as claim 5, claim 8 is not anticipated by Nunez et al.

Claims 3, 5, and 7-9 have been rejected under 35 USC 102(b) as being anticipated by Heyes et al. What Heyes et al. discloses is cyclodextrin containing naturally occurring ^{13}C . In contrast, what the present invention discloses is ^{13}C -labeled (i.e. enriched) cyclodextrin. As explained on page 12, line 3 from the bottom to page 13, line 2, the term, " ^{13}C -labeled," indicates an ^{13}C abundance ratio higher than the naturally occurring ratio. Thus, Heyes et al. does not disclose ^{13}C -labeled (i.e. enriched) cyclodextrin of the present invention. However, only to expedite the allowance of the application, the term cyclodextrin is deleted from the claims. Thus, this rejection has been rendered moot in view of the amendment.

Furthermore, claim 9 has been amended to cite compounds found on page 13 of the specification. Those compounds are not disclosed, taught, or suggested by the cited prior art.

Claim Rejections – 35 USC §103

Claims 3, 5, and 7-9 have been rejected under 35 USC 103(a) as being unpatentable over Jindrich et al. in view of DeRosch et al. These references have been cited to reject ^{13}C -labeled cyclodextrin. References to cyclodextrin have been deleted from all the pending claims. Thus, the rejection has been rendered moot in view of the amendments.

New Claims

Claims 64 and 65, which are similar to claim 5, are patentable over the cited references at least for the same reason as claim 5. Furthermore, in these claims the galactosyl group is not labeled with ^{13}C as indicated by the bolded features below.

Claim 64 (new): A ^{13}C -labeled oligosaccharide or polysaccharide, or a salt thereof for measuring pancreatic exocrine function, comprising:

at least one sugar molecule constituting the oligosaccharide or polysaccharide is ^{13}C -labeled, and at least one sugar molecule being modified with at least one modifying group,

wherein said modifying group is selected from a group consisting of a galactosyl group, a digalactosyl group, a carbamoyl group, a pyrimidino group, an ethylidene group, and a benzylidene group.

Claim 65 (new): A ^{13}C -labeled oligosaccharide or polysaccharide, or a salt thereof for measuring pancreatic exocrine function comprising:

at least one sugar molecule constituting the oligosaccharide or polysaccharide being modified with at least one modifying group,

wherein said sugar molecule or modifying group is ^{13}C -labeled, and said modifying group is selected from a group consisting of a digalactosyl group, a carbamoyl group, a pyrimidino group, an ethylidene group, and a benzylidene group, **wherein said sugar molecule is ^{13}C -labeled and said modifying group is a galactosyl group.**

Thus, claims 64 and 65 are not anticipated by the cited references also for this reason.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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